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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,816	01/24/2002	Ronald L. Mahany	36500ZXD	4621

7590 05/14/2008
Christopher C Winslade
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EXAMINER

VO, NGUYEN THANH

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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05/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/057,816	Applicant(s) MAHANY, RONALD L.	
	Examiner NGUYEN VO	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-31, 75, 76, 78-89, 91-101, 103-112, 115-126, 128-140 and 142-156 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-31 is/are allowed.
- 6) ☒ Claim(s) 75, 76, 78-89, 91-101, 103-112, 115-126, 128-140 and 142-156 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 07/973,237.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/20/2008 has been entered.

2. It is determined that the claimed invention of claims 26-34, 72-150 are not supported by the disclosure of the parent application 07/973,237 filed on 11/09/1992. Accordingly, the claimed invention of claims 26-34, 72-150 and newly-added claims 58-71 are not supported by the disclosures of the European Patent Application EP89114386.9 filed on 08/03/1989, and international application PCT/US90/03282 filed on 06/07/1990.

Since the present application has several parent applications, it is important to determine the effective filing date of the claimed invention of each claim. As best understood by examiner, the claimed invention of claims 26-31 has the effective filing date of 07/06/1992 which is the filing date of the parent application 07/910,865, wherein *a mobile station for which a communication link has not been established evaluates transmission from a base station to one or more transceiver units for which communication links have been established, and selects transmission rate.*

The claimed invention of claims 32-34, 72-87, 112-137 has the effective filing date of 08/04/1989 which is the filing date of the parent application 07/389,727, wherein *a mobile station selects transmission rates based on channel quality*.

The claim invention of claims 88-111, 138-150 has the effective filing date of 08/04/1988 which is the filing date of the US Patent 4,910,794, which discloses *selecting transmission rates based on channel quality*.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 75-76, 78-89, 91-101, 103-112, 115-126, 128-140, 142-156 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37-112 of copending Application No. 10/833,023. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 75-76, 78-89, 91-101, 103-112, 115-126, 128-140, 142-156

are just different wordings of claims 37-112 of the mentioned-above copending Application No. 10/833,023.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

5. Claims 26-31 are allowed.

Response to Arguments

6. Applicant's arguments with respect to claims 26-31, 75-76, 78-89, 91-101, 103-112, 115-126, 128-140, 142-156 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the objection to the specification:

Applicant argues that the issue as to whether new matter was allegedly added or not is moot since new matter may be added in a continuation-in-part application (the present application has been amended on 03/20/2008 that it now is a continuation-in-part of application No. 09/934,457 filed 08/21/2001, and that it is now a continuation-in-part of application No. 09/799,340 filed 03/05/2001). The examiner finds applicant's argument persuasive. Accordingly, the newly-added first two pages of the present specification are not longer objected to under 35 U.S.C. 132.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NGUYEN VO whose telephone number is (571)272-7901. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nguyen Vo/
Primary Examiner, Art Unit 2618
05/11/2008